



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/842,896	04/27/2001	Masaharu Hayashi	0425-0836P	7584

2292 7590 08/13/2007  
BIRCH STEWART KOLASCH & BIRCH  
PO BOX 747  
FALLS CHURCH, VA 22040-0747

EXAMINER
----------

PRYOR, ALTON NATHANIEL

ART UNIT	PAPER NUMBER
----------	--------------

1616

NOTIFICATION DATE	DELIVERY MODE
-------------------	---------------

08/13/2007

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

## Office Action Summary

**Application No.**

09/842,896

**Applicant(s)**

HAYASHI ET AL.

**Examiner**

Alton N. Pryor

**Art Unit**

1616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 25 May 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☐ Claim(s) 4,6-8,10,12 and 14-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) 10,16,18 and 22 is/are allowed.
- 6) ☐ Claim(s) 4,6-8,12,14,15,17,19-21 and 23-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

Art Unit: 1616

Applicant's arguments, see paper, filed 5/25/07, with respect to the rejection(s) of claim(s) under 35 USC 102 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of rejection below.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 4,6-8,12,14,15,17,19-21 will not remain rejected under 35 U.S.C. 102(b) as being anticipated by Kim et al (USPN 5674897; 10/7/97). Kim teaches a composition comprising 10 – 20,000 ppm C8 to C14 fatty acid esters plus a surfactant plus water (nutrient). Kim teaches a method of applying the composition to plants to control nematodes. Kim does not state that invention activates or promotes plant growth. See abstract, column 4 lines 1-63, column 8 lines 58-65, and claims 1-4. However, it is obvious that if the composition is applied to the plant that it would activate plant growth (promote permeation) since active step in the prior art and instant claims is the same ,i.e., both disclose a method of applying the composition to plants.

***Response to Applicants' Argument***

Applicants have amended claims to remove the C14 fatty acid ester. A new ground of rejection is set forth below.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4,6-8,12,14,15,17,19-21 are rejected under 35 USC 103(a) as being obvious over Kim et al (USPN 5674897). New claims 23 and 24 are added to this rejection.

Kim teaches a composition comprising 10 – 20,000 ppm C14 fatty acid esters plus a surfactant plus water (nutrient). Kim teaches a method of applying the composition to plants to control nematodes. Kim does not teach the invention comprising C15-C19 fatty acid esters as claimed. However, in view of Kim it would have been obvious at the time of Kim's invention to try a C15 fatty acid ester. One would have been motivated to do this because C14 and C15 fatty acid esters are homologs only differing by one carbon atom. Thus, compounds as such would have been expected to possess similar chemical and physical properties and therefore, when applied in the same utility would have been expected to yield a very similar result. Kim does not teach an invention where an ester-containing nonionic surfactant is employed as instantly claimed. However, it would have been obvious to try ester-containing nonionic surfactant in the instant invention since Applicant provides no unexpected results for the use of their ester-containing nonionic surfactant over the use of Kim's

Art Unit: 1616

nonylphenylether surfactant. Kim does not state that the invention activates or promotes plant growth. See abstract, column 4 lines 1-63, column 8 lines 58-65, and claims 1-4.

However, it is obvious that if the composition is applied to the plant that it would activate plant growth (promote permeation) since active step in the prior art and instant claims is the same, i.e. both disclose a method of applying the composition to plants.

Claims 25-29 are rejected under 35 USC 103(a) as being obvious over Kim et al above. Kim teaches a composition comprising 10 – 20,000 ppm C8-14 fatty acid esters plus a surfactant plus water (nutrient). Kim teaches a method of applying (pipetting) the composition to plants to control nematodes. Kim does not teach an invention where an ester-containing nonionic surfactant is employed as instantly claimed. However, it would have been obvious to try ester-containing nonionic surfactant in the instant invention since Applicant provides no unexpected results for the use of their ester-containing nonionic surfactant over the use of Kim's nonylphenylether surfactant. Kim does not teach a method involving the spraying of the composition onto plants as claimed.

However, it would have been obvious to try just above any application in the absence of unexpected results for spraying especially as compared to pipetting. Kim does not state that the invention activates or promotes plant growth. See abstract, column 4 lines 1-63, column 8 lines 58-65, and claims 1-4. However, it is obvious that if the composition is applied to the plant that it would activate plant growth (promote permeation) since active step in the prior art and instant claims is the same, i.e. both disclose a method of applying the composition to plants.

***Allowable Subject Matter***

Art Unit: 1616

Claims 10,16,18,22 are allowable. The prior art provides unexpected results for the instant plant activating agent plus fertilizer.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

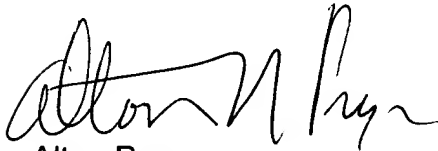
***Telephonic Inquiry***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alton N. Pryor whose telephone number is 571-272-0621. The examiner can normally be reached on 8:00 a.m. - 4:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1616

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

A handwritten signature in black ink, appearing to read 'Alton Pryor', is written over the printed name.

Alton Pryor  
Primary Examiner  
AU 1616